

REMARKS

A. 35 U.S.C. §103

Claims 25-35 and 37-47 were rejected under 35 U.S.C. § 103 as being obvious in view of the ENC-150 Encoder Mounting Instructions (hereinafter “AcuRite Manual”) and Nygren. Applicant has canceled claims 30-32, 34, 35, 42-44, 46 and 47 and so their rejections have been rendered moot. Regarding the rejection of the remaining claims, independent claims 33 and 45 each recite a method that includes attaching a template to a reading head bracket, which is attached to a machine tool, subsequent to positioning the template. It is noted that the Office Action has conceded that the AcuRite Manual does not disclose such attaching. In order to overcome the deficiencies of the AcuRite Manual, the Office Action has asserted that Nygren discloses a method of mounting that involves a template and that it would have been obvious to attach Nygren’s template to the reading head bracket disclosed in the AcuRite Manual.

Applicant traverses the above-described rejection for several reasons. First, Nygren is directed to nonanalogous art, which is improper under 35 U.S.C. § 103. The test for nonanalogous art is as follows:

The determination that a reference is from nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably

pertinent to the particular problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 230 U.S.P.Q. 313 (Fed. Cir. 1986) citing In re Wood, 559 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979).

Upon applying the first prong of the test, it is apparent that Nygren is not within the Applicant's field of endeavor. Applicant's claimed invention is in the field of methods of mounting a position measuring device to a machine tool. In contrast, Nygren does not relate in any way to methods of mounting a positioning measuring device to a machine tool. Instead, Nygren is directed to an apparatus for marking a structural member, such as wall plates or sill plates, the correct position for interconnecting structural building members, such as studs, joists, rafters, trusses and rough door opening trimmer studs. (Col. 2, ll. 13-18). Since there is no mention in Nygren of mounting a position measuring device to a machine tool, Nygren is not within Applicant's field of endeavor. It is noted that the Office Action has not contested this.

Besides not being within the Applicant's field of endeavor, it is clear that Nygren is not reasonably pertinent to the particular problem with which the Applicant was involved. As stated on pages 3 and 4 of Applicant's specification, the problem of multiple attachments and removals of linear encoders and their components to mark and form holes are a concern of Applicant's claimed invention. It is clear that Nygren does not address Applicant's problem. In particular, Nygren concerns the problems

encountered by marking building materials using either a tape measure and/or carpenter's square. (Col. 1, ll. 7-68). Such marking involves generating lines around templates that are attached to a guide member 1. (Col. 3, ll. 16-24).

The Office Action has challenged the above analysis by asserting that the particular problem that the Applicant was involved with was "marking positions of parts to be fixed to a structural member so as not to damage or overly handle the parts." However, a review of Applicant's own specification does not reveal any mention that Applicant was concerned with the problem of damage of the parts. This fabrication of Applicant's problem is improper and evidence that the rejection is improper.

Regarding the assertion that Applicant's problem regards overly handling the parts, there is no specific mention of such a problem in Applicant's specification. Assuming for arguments sake that Applicant addressed such a problem, there is no mention in Nygren that it is related to such a problem. The Office Action has relied on Col. 2, ll. 13-30 of Nygren as disclosing such a problem. However, there is no mention in this passage that there is a problem of overly handling the parts. Indeed, the passage only mentions the problems of time consumption, physical exertion, eye strain and mistakes made during the laying out process (Col. 1, ll. 7-9 and 19-20). Further problems listed in the passage are the swiveling nails, inaccurate centers, being limited by the length of the tape and the need for making square lines (Col. 1, ll. 32-42). Clearly, the

Office Action has ignored the teachings of Nygren and invented a problem that Nygren is not concerned with. Based on the above discussion, Nygren fails the second prong of the test. Accordingly, it is respectfully submitted that a person having ordinary skill in the art of designing improved methods for mounting a position measuring device to a machine tool would not, without other suggestion, turn to the completely non-analogous device of Nygren used for building materials. For this reason alone it is felt that the argued combination is inappropriate and that claims 25-29, 33, 37-41 and 45 should be allowed.

Even should Nygren be deemed analogous art, it is respectfully submitted that the combination of the AcuRite Manual and Nygren under § 103 is improper, because of a lack of motivation to do so. For example, claims 33 and 45 each recite attaching the template to the reading head bracket. The Office Action has conceded that the AcuRite Manual does not disclose using a template. The Office Action has relied on Nygren to cure the deficiencies of the AcuRite Manual by asserting that it would have been obvious to mount Nygren's template to the reading head bracket disclosed in the AcuRite Manual. As pointed out in Applicant's Amendment of April 14, 2003, the entire contents of which are incorporated herein by reference, there is no motivation to attach any one of Nygren's rectangular templates 2, 3 to the reading head bracket disclosed in the AcuRite Manual.

Applicant pointed out in his April 14th Amendment that Nygren made no mention

that holes are marked and instead disclosed that the pencil 18 draws an outline around a template 3. (Col. 3, ll. 16-24). The holes 5-10 are used to attach templates 2, 3 at various positions along the guide member 1 and are not used mark positions of holes. (Col. 3, l. 62 – Col. 4, l. 53). This is further evidenced by FIG. 1, where there is no surface behind guide member 1 that could receive a marking generated by inserting the pencil through one of the holes. Indeed, the only surfaces to receive markings are wall plates 17, but they lie below the holes and so marking of the plates 17 via the holes is impossible. (See FIGS. 1-2). Since the holes 5-10 are not used for marking, the guide member 1 itself is not used as a template. Surprisingly, the present Office Action has not addressed this argument and has merely repeated the arguments made in the previous Office Action mailed on January 14, 2003. Since it is improper not to answer the substance of Applicant's argument (MPEP § 707.07(f)), Applicant demands that this argument be addressed in the next Office Action. If it is not addressed, then it should be deemed an admission that Applicant's argument has merit and that improper hindsight is being used to reject the claims. For the above reasons the rejection has no merit and so should be withdrawn.

It should be noted that even if there was prior art indicating that a template for mounting a position measuring device to a machine tool was known. There still has been no showing that one of ordinary skill in the art would be motivated to attach such a

template to the reading head bracket described in the AcuRite Manual. Without such motivation, the claims should be allowed.

Claims 33 and 45 have been amended so as to clarify that the template includes a plurality of holes that correspond to all necessary mounting holes. In contrast, each of Nygren's templates 2, 3 has a single hole. As pointed out above, each hole is not used for marking. However, assuming for arguments sake each hole is used for marking a hole in the guide member 1, the templates 2, 3 do not anticipate or suggest the claimed template. In particular, the guide member 1 has a plurality of holes formed therein for attachment between the guide member 1 and the individual templates 2, 3. Since each template 2, 3 has only one hole, it follows that each template does not contain a plurality of holes that correspond to the necessary holes of the guide member 1. This is further shown by the fact that each of the templates 2, 3 has a length that is less than the length between the two furthest holes of the guide member 1 and so no one template 2, 3 can be used to form all of the holes of the guide member 1 without moving the template to the next hole to be formed in the guide member and marking the hole via the template. Since there is no suggestion in Nygren to have a template with a plurality of holes that correspond to all the necessary mounting holes of the machine tool of the Acu-Rite manual, the rejection is overcome and should be withdrawn.

The rejection is overcome for the additional reason that the claims have been

amended to clarify that all the necessary mounting holes on the machine tool are marked through the plurality of holes of the template. As mentioned above, Nygren does not disclose or suggest having multiple holes in a template that correspond to all of the necessary mounting holes and so it follows that there is no suggestion to mark all necessary mounting holes via a plurality of holes in Nygren's templates. Accordingly, the rejection is overcome and the claims allowed.

The rejection is also overcome because claims 33 and 45, as amended, recite that the template is detached from the reading head bracket. Since Nygren fails to disclose or suggest such detaching, the claims are allowable over the combination of the Acu-Rite Manual and Nygren. Accordingly, the rejection is overcome.

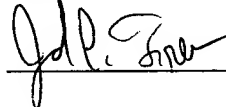
B. New Claims 48-54

New claims 48-54 depend directly or indirectly on independent claims 33 and 45 and so are patentable for at least the same reasons given above in Section A with respect to claims 33 and 45. Note that claims 48-54 are being added to provide further coverage for the methods of mounting recited in the claims and so are not related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722, 122 S. Ct. 1831 (2002).

CONCLUSION

In view of the arguments above, Applicant respectfully submits that all of the pending claims 27-29, 33, 37-41, 45 and 48-54 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, she is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,



John C. Freeman
Registration No. 34,483
Attorney for Applicant

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4200

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